

Remarks

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is respectfully requested.

At page 2, the first full paragraph, the Examiner has withdrawn the restriction requirement, and the latter is most appreciated.

Claims 12 through 19 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing "to comply with the enablement requirement." Based upon the reasons given by the Examiner for this rejection, it is believed that the rejection is more suited to a rejection based upon the second paragraph of 35 U.S.C. § 112 which requires claims to "particularly" and "distinctly" claim the subject matter which Applicant regards as his invention. Whatever might be the appropriate rejection, be it predicated upon the first or second paragraphs of 35 U.S.C. § 112, the claims have been appropriately amended to avoid either rejection, particularly new claim 20 which replaces cancelled claim 12. As the Examiner pointed out in the rejection of claim 12, "Applicant has set forth that the side wall contains the flare, constant diameter and taper," and thus any of the diameters D_2 and D_3 must necessarily define the particular portion (flare, constant diameter or taper) of the overall side wall which is intended. Such is believed to be provided in new claim 20 which initially recites a metal container comprising "a base, an axially opposite open ended side wall and a ring component." As will be emphasized further herein, claim 20 also recites "the base and the ring component being formed from the **same sheet of metal** and fastened to opposite ends of the axially opposite open ended side wall."

Limitation a) of claim 20 recites that the container side wall is flared outwardly to a diameter D_2 at the end to which the ring component is fixed." Figure 1(d) clearly identifies the end or end portion 16 which is "flared outwardly" to the diameter D_2 , obviously indicated by the double-headed arrow associated therein in Figure 1(d). Therefore, there can be no doubt as to the meaning of the flared portion of the container side wall.

Limitation a) also recites a diameter D_1 of "a central section of the container side wall, the central section being of a substantially constant cross-section." Once again and as best viewed in Figure 1(d), there can be no doubt as to that section of the container side wall which is identified as the "central section" (15).

Limitation b) of claim 20 further calls for the container side wall as being "tapered inwardly to a diameter D_3 at the end to which the base is fixed." As was noted parenthetically heretofore, claim 20 specifically defines the fact that the base and the ring component are "fastened to opposite ends of the axially opposite open ended side wall." Quite clearly, that portion of the container side wall which is "tapered inwardly" is the portion 17 of Figure 1(d) with which is associated the dimension D_3 .

Based upon the foregoing, the 35 U.S.C. § 112 rejection of claim 12 based upon the first paragraph (or the second paragraph) thereof is believed inapplicable to new claim 20.

The final two issues of record involve the rejection of claims 12, 15, 18 and 19 under 35 U.S.C. § 102(b) and claims 13, 14, 16 and 17 under 35 U.S.C. § 103(a) as allegedly being respectively anticipated and unpatentable

over the patent to Palisin, Jr. et al. (5,160,031). Before considering the inapplicability of the Palisin, Jr. et al. patent to either anticipate or render obvious the latter-noted groups of claims, it is emphasized that the present invention has as a major object thereof the reduction of metal waste by utilizing a **single** sheet of metal to form **both** the annular ring 1 (Figure 1(c)) fastened to the upper end (as illustrated) of the container side wall and the base 4 (fastened to the lower end of the side wall) with the base being punched out of the middle of the annular ring. The difference in diameter between the upper end of the side wall D_2 and the lower end of the side wall D_3 is that which enables the annular ring 1 and the base 4 (which is inherently smaller in size than the annular ring) to be fastened to the side wall. The latter is specifically described beginning at page 4, paragraph [0015] of the specification. The latter paragraph makes specific reference to Figures 1(a) through 1(c) and states: "ring 1 and end 4 are formed from the **same** sheet metal 5 by drawing the metal sheet into a shallow cup 6 Base 11 of the cup 6 is severed close to the cup wall 12 so as to form a stepped disk 13 which is subsequently to be used for forming the base of the container," etc. As further set forth at paragraph [0018] at page 5: "In accordance with the invention, the dimensions of the features are selected so as to enable the ring 1 and end 4 to be manufactured from a **single sheet of metal.**"

The invention as thus described in the specification is claimed in compliance with 35 U.S.C. § 112, paragraphs 1 and 2, to specifically define the portions 15, 16 and 17 of the container side wall and the respective

diameters D_1 , D_2 and D_3 thereof. Obviously, important to the invention from the standpoint of achieving the object of reducing metal wastage is that of "the base and the ring component being formed from the **same sheet of metal**" and, of course, being "fastened to **opposite ends** of the axially opposite open ended side wall" (claim 20).

In the rejection of claims 12, 15, 18 and 19 under 35 U.S.C. § 102(b), the Examiner described many aspects of the Palisin, Jr. et al. patent, but totally absent therefrom is any mention of structure which allegedly anticipates "the base and the ring component being formed from the same sheet metal" (claim 12).

As was stated in Stoller v. Ford Motor Co., 18 USPQ 2d 1545, 1546:

A prior art reference anticipates a claim, and thus invalidates it under 35 U.S.C. § 102, if that reference discloses each and every element of the claim.

The latter-quoted phrase from now cancelled claim 12 finds no counterpart in the Palisin, Jr. et al. patent.

Claim 20 has been limited beyond the scope of claim 12 with respect to the limitation "the base and the ring component being formed from the same sheet metal" (Claim 12). In lieu of the latter language, claim 20 recites: "**the same sheet of metal.**" This avoids any misintended broadened interpretation of claim 20 and requires, in order for a proper rejection, that the prior art teach the base **and** ring component being formed "from the **same sheet of metal.**"

It is obvious from considering the Palisin, Jr. et al. patent in its entirety or as a whole that it does not disclose an annular ring and a base being

formed from "the same sheet of metal." The lack of disclosing the latter is not surprising because the object of Palisin, Jr. et al. is totally unrelated to the present invention, namely, the object is to provide a nestable container to achieve efficient stacking during transportation/storage. (See column 1, lines 45 through 60.) More importantly, since the Examiner has referred to a side wall 112 and a curled rim 114 of the Palisin, Jr. et al. patent, he obviously is referring to the container 110 described beginning at column 6, line 32 which in addition to the side wall 112 and the curled rim 114 has a circular bottom wall 120 which collectively defines a **one-piece drawn** container not a container which has "an **axially opposite open ended** side wall" to which a base and ring component are "fastened to opposite ends of the axially opposite open ended side wall" (claim 20). Obviously, the latter-quoted limitation finds no counterpart in the Palisin, Jr. et al. patent, and irrespective of the Examiner's perceived diameter dimensions and relative diameter dimensioning, the Palisin, Jr. et al. patent when considered in its entirety or as a whole is completely incapable of anticipating or rendering obvious claim 20 and the remaining claims depending directly or indirectly therefrom.

With respect to the Section 103(a) rejection based upon the Palisin, Jr. et al. patent, the reasons set forth earlier herein with respect to the Section 102(b) rejection are applicable and are incorporated hereat by reference. Furthermore, the undersigned agrees with the Examiner that "Palisin does not disclose the differences between upper and end diameters." The question which should come to mind is: Why? The reasons were stated

earlier by the undersigned, namely, Palisin, Jr. et al. does not disclose the differences between upper and lower diameters because Palisin, Jr. et al. (1) does not have a container body which is axially opposite open ended, (2) does not form a base and a ring component "from the **same sheet of metal**," and (3) there is no base **and** ring component **fastened** to respective opposite ends of the open ended side wall.

The Court of Appeals, Federal Circuit in Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597, made reference to the Supreme Court's decision in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966):

[8] While the ultimate question of patent validity is one of law, A. & P. Tea Co. v. Supermarket Corp., supra, at 155, 87 USPQ at 307, the § 103 condition, [that is not obvious] ... lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

There is no doubt that "the scope and content of the prior art" patent to Palisin, Jr. et al. is totally unrelated to the invention recited in the claims of record. The undersigned has emphasized "the differences between the prior art (Palisin, Jr. et al.) and the claims (claim 20) at issue," and there is no doubt that such differences have been clearly "ascertained."

Finally, no matter the perceived "level of ordinary skill" in this art, the differences recited at claim 20 at virtually any level of ordinary skill in the art would not flow from, or be taught or motivated by the teaching of Palisin,

Jr., et al., when considered in its entirety or as a whole. Accordingly, the withdrawal of the rejection based upon 35 U.S.C. § 103(a) is believed to be in order and would be most appreciated.

Based upon the foregoing and in the absence of pertinent prior art, the allowance of the claims of record at an early date is herewith respectfully requested.

Very respectfully,

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Enclosure: Petition re Extension/check